



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,582	10/17/2003	Rajesh Kumar	08688-056001 / UML 02-16,	2269
26161	7590	06/16/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			KOSSON, ROSANNE	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,582	<b>Applicant(s)</b> KUMAR ET AL.	
	<b>Examiner</b> Rosanne Kosson	<b>Art Unit</b> 1651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 6, drawn to a method of synthesizing a polyorganosilicone polymer or alkylene glycol-based polyester polymer, classified in class 435, subclass 131.
- II. Claims 1, 3 and 6, drawn to a method of synthesizing an alkylene glycol-based polyester polymer, classified in class 435, subclass 135.
- III. Claims 1, 4 and 6, drawn to a method of synthesizing an alkylene glycol-based polyester polymer, classified in class 435, subclass 135.
- IV. Claims 1, 5 and 6, drawn to a method of synthesizing an alkylene glycol-based polyester polymer, classified in class 435, subclass 135.
- V. Claims 7-9, drawn to a polyorganosilicone, classified in class 428, subclass 447.
- VI. Claim 10, drawn to a method of preventing fire, classified in class 252, subclass 609.
- VII. Claim 11, drawn to a method of incorporating a third monomer in a preformed polymer, classified in class 424, subclass 94.6.

The inventions are distinct, each from the other because of the following reasons.

Inventions I and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2)

Art Unit: 1651

that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the polyorganosilicones could be made synthetically and need not be made enzymatically by using a lipase, esterase or protease. Additionally, the method of Group I could be practiced with monomers, oligomers or macromers to produce polymers other than the polyorganosilicones of Group V. Thus, restriction of these groups is proper.

The inventions of Groups I-IV are materially different processes, each producing a different group of polymers, where each polymer group has a different structure compared to the other groups. Because the products are different groups of molecules, each group is considered a patentably distinct product group, and separate searches would be required. This creates an undue burden of search, and restriction is, therefore, proper.

The processes of Groups II-IV and VII do not produce or use the polymers of Group V, and these processes, with respect to Group V, are therefore unrelated inventions. Because these inventions are distinct and have acquired a separate status in the art as shown by their classification, restriction for examination purposes as indicated is proper. Furthermore, the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Inventions V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

process of using that product (MPEP § 806.05(h)). In the instant case, the polyorganosilicones of Group V may be used as antioxidants, biodegradable matrices for therapeutic compounds, packaging materials and thermal insulators. Thus, restriction of these groups is proper.

The processes of Groups I-IV and VI-VII are unrelated inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to methods of synthesizing different polymers (Groups I-IV), a method of preventing fire (Group VI) and a method of incorporating a third monomer in a preformed polymer (Group VII). As these inventions clearly have different modes of operation, different functions, and different effects, as shown in some cases by their classification, restriction for examination purposes as indicated is proper.

Additionally, this application contains claims directed to the following patentably distinct species of the claimed invention:

- (a) the substituents R, R' and R'' of claims 2-5, 7, 8 and 10,
- (b) the substituents A and B of claims 2-5, 7, 8 and 10,
- (c) the substituent T of claims 3-5 and 7-8,
- (d) the variables x and n of claims 2-5, 7, 8 and 10,
- (e) the variable y of 5, 7, 8 and 10,

Art Unit: 1651

(f) one type of component of claim 6 or one combination of components. Should Applicants elect Group I, a substituent must be elected for each of R, R', R'', A and B, an integral must be elected for each of x and n, and a component or a combination of components must be elected from claim 6. Should Applicants elect Group II or Group III, a substituent must be elected for each of R, R', R'', A, B and T, an integral must be elected for each of x and n, and a component or a combination of components must be elected from claim 6. Should Applicants elect Group IV, a substituent must be elected for each of R, R', R'', A, B and T, an integral must be elected for each of x, y and n, and a component or a combination of components must be elected from claim 6. Should Applicants elect Group V or Group VI, a substituent must be elected for each of R, R', R'', A and B, and an integral must be elected for each of x, y and n.

Thus, depending on which of the above Groups I to VII Applicants elect, Applicants are also required under 35 U.S.C. 121 to elect a single disclosed species of the substituents, variables and components within the elected group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 2-5, 7, 8 and 10 are generic.

For example, if Applicants elect Group I, a proper reply to the restriction requirement would read as follows: Applicants elect to prosecute the invention of Group I, drawn to a method of synthesizing a polyorganosilicone polymer or alkylene glycol-based polyester polymer. Within Group I, Applicants elect the species of hydrogen, hydroxyl and amino represented by R, R' and R'', respectively, the species of alkyl and alkoxy represented by A and B, respectively, the integrals 2 and 200, represented by x

and n, respectively, and the at least three components as recited in claim 6 are aliphatic.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rosanne Kosson  
Examiner  
Art Unit 1651

rk  
2004-06-14



FRANCISCO PRATS  
PRIMARY EXAMINER